

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Offic**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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ABRAMS, N

2839

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

10/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N.

09/024885

Applicant(s)

Examiner

Abra.ms

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 8-12-99 (c/m 8-9).

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 34 - 67 is/are pending in the application.

Of the above claim(s) 42 and 46 - 58 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 34 - 67 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Fig. 22, "362" is not seen. Spec. page 59 line 11 is unclear.

Claims 42 and 46-58 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 8.

These claims do not appear to be directed to the elected species of figs. 22-25 and should be cancelled.

These claims are discussed below, but only to provide for the possibility that they be shown to be readable on elected species.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claim 42 antenna, claim 45 (fig. 22) "conductors in the recess means", claim 46 device with pivoted cover and pivoted clip holder attached to the communications card, and clip holder with an "aperture" to receive a clip, claim 48, biasing means claim 49, pivotal attachment point, claim 52, "pivotally attached clip holder" and clip holder "aperture", claim 53, "V-shaped" parts, claim 55, "pivotal attachment" and claim 63, "means for biasing" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

In each case the items at issue should be pointed out by fig. no. And numeral.

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Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claims 45-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are found confusing and not to be clearly readable on the elected or other species.

Claims 60-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 60, line 10 terms "means for moving" seem incorrect since, no such operating mens are present in the connector. It is plug insertion that moves the bottom out of the drawer. Claim 63, term "biasing" implies use of a spring rather than the ~~level~~ 404, should --urging-- be used as in spec. Also "plug---drawer" seem incorrect, should it be --drawn is moved to a closed position--.

The spec. is objected to for failure to provide disclosure of the claims 46-58 assemblies for reasons noted above with regard to the drawings. Exactly how these claims are to be readable on elected species should be pointed out. For claim 45, (fig. 22), the conductor 368 are shown in

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a sketchy manner that does not clearly show them to be "in the recess" in the cover that receives the plug. Not is such aspect discussed in the spec.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 44-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aldous alone or in view of Okada.

See Aldous, fig. 10, 15, drawer 72 cutout 94. For claims 44, 52 see pivotal clip holders 132, 144, 160, 174.

For claim 60, clip 174 is read as forming a bottom for the recesses 130, 172, figs. 21, 22.

Alternatively, obvious to use a bottom like that of Okada at 18.

Claims 42-67 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beckham alone or taken in view of Okada.

Beckham figs. 15-22 applied similarly to Aldois. Also see, for claim 45, fig. 24 pivoting cover 210 and recess between 210 and base 72; for claim 64, figs. 28-36, drawers with openable jaws 236, 238, etc.

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For claim 60, the Figs. 30-34, part 252 also read as a movable bottom. Also obvious to form fig. 16 device with a movable bottom in view of Okada at 18. For claim 45, also see figs. 28, 29 device with pivoting cover 236 and conductors 124.

Claims 45-59, and 64-67 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitani.

Note movable drawer, figs. 5, 6 with pivotal parts 53a, 53b, readable as covers, clip holders or jaws. For claim 45, the lower jaw is read a pivotal cover. Also see movable drawer 23 in fig. 1.

Claims 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldois in view of Gargiulo, Kakinoki and Mitani. Obvious to form Aldois connector part 72 as a plug-in connector like 431 of Gargiulo, 84 of Mitani or 1 of Kakinok or like the plug of Aldois, fig. 7 at 52. ^{Should the} feature be at issue, use of latches for such mating connectors is noted to be a well known expedient. Alternating, obvious to form the Aldois part 52 with a socket like that in member 72.

Claim 45 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gargiulo.

See part 433 read as a pivoting cover.

Claims 34-45 and 59-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McDaniels.

For claims 34-43 see fig. 6, assembly with body 150 and connector 151. For claims 44 and 60-63 see fig. 2 device with cutout at 18 and member 114 readable as a "bottom" of the

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recess. For claim 45, note connector 202 (figs. 12, 13) with pivoting cover 208. With connector 202 joined to a communication card it could be read as a part of the card. Also obvious to form the cover so that the contacts 206 would be located in the cover recess. For claim 59 see figs. 4, 5, 11 devices with slidable drawers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-67 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 5,411,405 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims of this case define obvious and broadened variations of the parent case. Note inventor Glad common to both cases.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication should be directed to N. Abrams at telephone number (703) 308-1729.

Abrams/dc
October 7, 1999


NEIL ABRAMS
EXAMINER
ART UNIT 322